

### **REMARKS**

Claims 1, 3-4, 7-13, and 21-28 are pending. Claims 1 and 4 have been amended to clarify the scope of the invention. No new matter has been added.

The issue outstanding in this application is as follows:

- Claims 1, 3-4, 7-13, and 21-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by Gordon (US 5,892,577). Applicant traverses the rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Firstly, independent claim 1 has been amended without prejudice and without acquiescence to clarify that the currently pending claim 1 relates to an arrangement that comprises a disc having a plurality of detection areas in which each detection area is associated with a microcavity that is part of a microchannel structure in which aliquots of liquid can be transported and processed, a detector head, a disc holder, an angular aligning system and a controller. Gordon does not teach a disc having a plurality of detection areas that is associated with a microcavity that is part of a microchannel structure. At best Gordon teaches a disk having wells or indentations which contain the sample. A well or indentation does not equate to a microchannel structure in which liquid can be transported and processed. In view of this clarification, Applicants contend that the presently pending claims are not anticipated in view of the Examiner's assertion that the whole surface on one side of the disc in Gordon could be a detection area.

Furthermore the recitation in Gordon about electrophoretic gels, does not equate to a microchannel structure. Microcavities and Microchannel structures are described in the Specification at [0076] – [0082]. Applicants are confused by the Examiner's comments that the definition is "misplaced." Within these paragraphs, Applicants describe various specifications for microchannels, but the central theme is that a microchannel comprise one or more cavities and/or channels/conduits. This and is not associated with any of the other detection areas nor does Gordon teach a microcavity being part of a microchannel structure.

Next, Applicants are confused regarding the Examiner's comments concerning claims 5 and 6 at the bottom of page 3 of the Office Action. These claims were canceled in the response filed February 17, 2006, and furthermore, these claims were not listed on the Summary Page as being pending nor in the initial listing of the rejection on page 2 of the Office Action. Thus, these comments and rejections are moot since the claims were previously canceled.

Regarding claim 12, the Examiner has argued that Gordon discloses a black calibration mark on a disk and that claim 12 does not preclude non-black materials. (Examiner's Office Action of 05-03-2006, pg 3) Claim 12 is limited to black disks. Gordon does not disclose a black disk nor is a black disc necessarily present in the Gordon device. In fact, a completely black disk would negate the black mark element of Gordon and render such an embodiment inoperative. Thus, claim 12 is not anticipated by Gordon.

Regarding claims 21-28, the Examiner has once again failed to specifically address claims 21-28. To the degree these claims overlap with the above discussed limitations, these claims are also not anticipated by Gordon. Further, the claims contain additional limitations which the Examiner has not addressed. Rejection of these claims is therefore improper substantively and procedurally. Thus, in the next action, Applicants respectfully request that these claims be acknowledged as allowable subject matter since the Examiner has failed to provide any reasons for rejection.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Application No. 10/062,258  
Amendment dated August 7, 2006  
After Final Office Action of May 3, 2006

Docket No.: HO-P02314US1

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P02314US1 from which the undersigned is authorized to draw.

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Respectfully submitted,

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